

II. REMARKS

Claims 56 to 89 are pending in the subject application and stand variously rejected by the Office in the outstanding Office Action. By this Amendment and Response, claims 56, 57, 58, 62, 76, 81, 84 and 86 have been amended and claims 80 and 85 have been canceled without prejudice or disclaimer. These amendments are made without prejudice or disclaimer and are not intended to be a dedication to the public the subject matter of the claims or their equivalents, as filed or previously amended. Applicants reserve the right to pursue the claims as originally filed and further amended in a later filed continuation application.

Claims 56, 57, 81, 84 and 86 have been amended to specifically recite "neoplastic" cells as requested by the Office. Support for these amendments are found in the application papers on page 15, line 10. Claims 62 and 76 are amended herein to correct a typographical error pointed out by the Office, *i.e.*, -CH₃ has been substituted for a terminal -CH₂- group. Additional amendments have been made to correct typographical errors. An issue of new matter is not raised by these amendments and entry thereof is respectfully requested.

In view of the preceding amendments and remarks that follow, reconsideration and withdrawal of the objections to the specification and the rejections of the claims are respectfully requested.

Amended claims 56 to 79, 81 to 84 and 86 to 89 are currently under examination.

35 U.S.C. § 112, First Paragraph

Claim 85 stands rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office stated that reference in claim 85 is made to assays using compounds which have been disclosed generically or subgenerically. The Office alleged that this reference to compounds is excessively broad in light of the disclosure wherein only selected compounds have

been tested. Without conceding the correctness of the Office's position and to advance examination of this application, claim 85 has been canceled without prejudice or disclaimer.

Claims 56 and 57 and separately claims 56-61, 81-84 and 86-89, stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 56 and 57, the Office alleged that the claims are directed to treating specific diseases which have not been specified. The Office alleged that the term "hyperproliferative cell(s)" is excessively broad in view of the disclosure wherein only selected compounds have been tested and as to the types of cancer which can be treated.

Claims 62-80 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office alleged that in claims 62-80 reference is made to compounds which have been claimed generically and subgenerically. The Office opined that this is excessively broad in light of the disclosure wherein only selected compounds have been actually synthesized.

Applicants respectfully traverse, with respect to all claims rejected under 35 U.S.C. § 112, first paragraph and on all grounds for rejection.

Applicants reiterate that the Office Action does not provide any evidence the above-referenced teachings, in combination with what was known to those skilled in the art, does not enable the full scope of the claims.

However, without conceding the correctness of the Office's position and to advance examination of the claims, claims 56, 57, 81, 84 and 86 have been amended to specifically recite that the hyperproliferative cells treated by the methods of this invention are neoplastic cells. In view of this amendment, reconsideration and withdrawal of this ground for rejection is respectfully requested.

Applicants also direct the Office's attention to WO 01/07088 (copy enclosed) which discloses the efficacy of the compounds falling within the scope of the pending claims against

neoplastic colon and breast cells. Applicants further direct the Office's attention to U.S. Patent No. 6,683,061 (cited by the Office under the provisional obviousness-type double patenting rejection and therefore, a copy is not enclosed) which shows the synthesis of additional compounds falling within the scope of the claims.

Accordingly, in view of the above remarks and amendments to the claims and additional evidence, removal of all grounds for rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claim Objections

The Office objected to claims 58, 62 and 76. These claims have been amended herein in accordance with the Office's recommendations in an sincere effort to remove the grounds for objection. In view of these amendments, reconsideration and withdrawal of the objections is respectfully requested.

35 U.S.C. § 112, Second Paragraph

Claims 56-59, 61-63, 65, 72 and 81-87 remain rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In claim 57, the Office alleged that the term "hyperproliferative cells" is indefinite for failure to specify the particular disease being referred to. The Office further alleged that the term "pathological cell" fails to define the disease in claims 56, 58, 81-84, 86 and 87. In response to the rejection but without conceding the correctness of the Office's position, claims 56, 57, 81 and 84 have been amended to specifically recited "hyperproliferative neoplastic cells".

With respect to claims 56 to 58, the Office further noted that the terms "an electrophilic leaving group", "a phosphoryl or phosphoramidatyl", and "masked phosphoryl," are allegedly incomplete for failure to completely specify the chemical structures being claimed, which also makes searching of the claimed subject matter in its entirety impossible.

The Office further stated that in claim 58, the terms "a sugar substituent," "a thio sugar substituent," a carbasugar substituent," and "a seco-sugar substituent" are allegedly indefinite

because they fail to detail structure. Claim 58 was amended in the response filed February 27, 2004 to remove the offending language.

The Office also argued that in claim 59, the term “masked phosphoryl moiety and phosphoramidatyl moiety” are indefinite.

With respect to claim 62, the Office objected to the terms “aromatic hydrocarbyl” on the ground that it is unclear if Applicants intend to a group or a compound. The Office also object to the term on the ground that it fails to recite an upper size limit. The term “heteroaromatic” was also alleged to be incomplete for failure to define the identity or limits on the proportion of the heteroatom or heteroatoms present.

The Office remarked Applicants’ prior argument that the Office has not provided any evidence that the noted terms are not well known in the art or that the terms would not be understood by the ordinary practitioner upon inspection of the disclosure, unpersuasive. The Office respectfully disagreed and referred Applicants to the amended grounds of rejection which point out with particular examples the problem of indefiniteness caused by the noted term in its previous and its present iterations.

Applicants respectfully traverse for the reasons of record. However, without conceding the correctness of the Office’s position and to advance examination of the claims, some of the rejecting claims have been amended. With respect to the claims and phrases that remain without further amendment, Applicants reiterate that the claims employ language conventionally used in the art to which the invention pertains and therefore adequately define the metes and bounds of the claimed invention. *See, e.g., In re Miller*, 441 F.2d 689, 692-93, 169 U.S.P.Q. 597, 599 (C.C.P.A. 1971); *In re Kamal*, 398 F.2d 867, 870, 158 U.S.P.Q. 320, 322 (C.C.P.A. 1968).

In view of the preceding amendments and remarks, reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Provisional Double Patenting Rejections

Claims 56-61, 81-84 and 86-89 remain rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-12 of U.S. Patent No. 6,495,553.

Claims 62-80 remain rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 36-39 of U.S. Patent No. 6,339,151.

Claims 56-84 and 86-89 remain rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-7 of U.S. Patent No. 6,245,750 and claims 1-30 of co-pending application Serial No. 10/119,927.

Claims 56-61 and 81-89 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-22 of co-pending U.S. Serial No. 10/051,320.

Claims 62-80 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1 and 53 to 83 of co-pending application U.S. Serial No.: 10/681,418.

Claims 56-84 and 86-89 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1 to 10 of U.S. Patent No. 6,683,061.

Applicants respectfully defer responding to the objections until allowable subject matter is indicated in this application.

Double Patenting

Claims 56-84 and 86-89 allegedly conflict with claims 1 to 30 of co-pending application U.S. Serial No. 10/119,927, claims 1 to 22 of co-pending application U.S. Serial No.: 10/051,320 and claims 1 and 53 to 83 of co-pending application U.S. Serial No.: 10/681,418. The Office noted that 37 C.F.R. § 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicants submit that the good and sufficient reason for retention of such allegedly conflicting claims is that examination is still ongoing and the scope of the claims, while there may be some overlap, will be clearly delineated between the applications upon allowance of one or more claims. Accordingly, removal of this ground for rejection is respectfully requested.

Supplemental IDS

Attached to this Response is a Supplemental IDS for consideration and entry into the application file. Applicants would also like to bring to the Office's attention copending, co-assigned U.S. Serial No. 10/048,033.

III. CONCLUSION

No fee is deemed necessary in connection with the filing of this Supplemental Amendment and Response. However, if the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2518**, referencing billing number **2023896-7008263002**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account. Should a telephone advance prosecution of the subject application, the Examiner is invited to contact the undersigned at (650) 849-4950.

DATE:

June 1, 2004

Respectfully submitted,

By:

Antoinette F. Konski

Antoinette F. Konski

Registration No.: 34,202

Bingham McCutchen, LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4950
Telefax: (650) 849-4800